Application No.: 09/889,167

REMARKS

Claims 6-8, 14 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Asao et al. (JP '834; hereafter, "Asao") in view of Nakatsuka et al. '185 ("Nakatsuka"). Claims 6 and 8 are independent. This rejection is respectfully traversed for the following reasons.

Solely in order to expedite prosecution, independent claims 6 and 8 have been amended to clarify the distinction between the present invention and cited prior art. Claim 6 recites in pertinent part, "said article having an ***IC*** carrying said identification information" and claim 8 recites in pertinent part, "wherein said housing has an ***IC*** carrying identification information." The Examiner is directed to page 20, line 7 – page 21, line 17 of Applicants' specification for exemplary advantages that can be made possible by use of an IC over, for example, a bar code as used in Asao (e.g., increased storage, etc.); and page 21, lines 18-22 corresponding to Figures 12-13 of Applicants' drawings for a description of exemplary embodiments of the IC arrangement.

The cited prior art is completely silent as to using an IC for carrying identification information related to an article and/or housing. Indeed, Asao discloses only a bar code. Only Applicants have recognized a motivation/rationale for using an IC to provide identification information for an article and/or housing, and have conceived of a novel combination of elements to do so.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested ***by the prior art***. (emphasis added) (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in the pending claims because the cited prior art fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as the independent claims are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Withdrawn independent claims 11 and 12 have been amended similarly to claim 8 and are submitted to be patentable for at least the reasons discussed above regarding claim 8. Accordingly, the Examiner is respectfully requested to rejoin claims 11-13.

CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

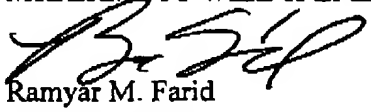
PAGE 8/9 * RCVD AT 10/6/2005 10:06:22 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/25 * DNIS:2738300 * CSID:202 756 8087 * DURATION (mm-ss):02-00

Application No.: 09/889,167

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Ramyar M. Farid
Registration No. 46,692

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 RMF:MWE
Facsimile: 202.756.8087
Date: October 6, 2005

Please recognize our Customer No. 20277 as our correspondence address.

PAGE 9/9 * RCVD AT 10/6/2005 10:06:22 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/25 * DNIS:2738300 * CSID:202 756 8087 * DURATION (mm-ss):02-00